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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,299	09/19/2001	Cecile Nocerino	13833.0007	8148
7590	01/06/2005		EXAMINER	
STEPTOE & JOHNSON LLP			BERKO, RETFORD O	
1330 Connecticut Ave., N.W.				PAPER NUMBER
Washington, DC 20036			1615	

DATE MAILED: 01/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/955,299	NOCERINO ET AL.	
	Examiner Retford Berko	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 03 March 2004.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 20-47 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 12-47 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

### **DETAILED ACTION**

**Acknowledgement:** Applicant's amendment filed March 3, 2004 is acknowledged.

#### **Status of Claims**

The status of the claims is as follows:

Claims 1-19 were previously withdrawn by applicant.

Claims 20-47 are pending following the amendment. Claims 42-47 were added as new claims.

The text of those sections of title 35 U.S.C. not included in this in this action can be found in a prior Office Action.

This Office Action contains New Grounds of Rejections.

#### **Rejections Withdrawn**

The rejection of claims 20-38 under 35 U.S.C. 102 (b) as anticipated by Tanner et al (US 5, 827, 508) is withdrawn in view of applicant's arguments and amendments to the claims. A new ground for rejection is made of record as explained in this office action.

The rejection of claims 33-36 under 35 U.S.C. 103 (a) as being unpatentable over Tanner et al (US 5, 827, 508) in view of Gosling et al (US 4, 359, 456) is withdrawn in view of applicant's arguments. A new ground for rejection is made of record as explained in this office action.

#### **Claim Objection**

Claim 22-23 are objected to as being dependent upon a rejected base claim 1, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### **New Matter**

This application presents a claim for subject matter not originally claimed or embraced in the statement of the invention (claims 44-47): The subject matter does not appear in the specification as filed. are drawn to a: (a) claims 44-45 are drawn toward a composition wherein the alumina “does not act” as coating agent for any filler present in the composition and (b) claims 46-47 are drawn toward a process of making the composition wherein the alumina “does not act as a coating agent for the filler in the composition. The subject matter disclosed in the specification as filed pertains to the process of using the composition for treating hair only (spec. at page 6) but does disclose the process of making the composition wherein the alumina “does not act as a coating agent for the filler in the composition.

A supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

**New Grounds of Rejections:**

**Claim Rejections-35 USC Sec 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20-21 are rejected under 35 U.S.C. 102 (b) as anticipated by Metzger et al (US 4, 035, 148).

The claims are drawn toward a composition comprising alumina particles (i.e. aluminium oxide or aluminium hydroxide or aluminium trihydrate) having a propellant (i.e. dimethyl ether or C3-C5 alkane or a mixture. The particles of alumina in the composition have size of 2-200 nm or between 5-50 nm.

Patent to Metzger et al (Patent '148) teaches a composition comprising alumina particles and a propellant (abstract, col 1, lin 55 and col 2, lin 47-55).

Patent '148 teaches a composition having alumina particles with size of 0.005 – 0.1 microns; 1 micron=1000nm and thus reads on claims 20-21.

Claims 20-21 are anticipated by Patent '148.

#### **Claim Rejections - 35 USC Sec 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 20-21 and 24-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanner et al (US 5, 827, 508) in view of Metzger et al (US 4, 035, 148).

The claims are drawn toward a composition comprising alumina particles (i.e. aluminium oxide or aluminium hydroxide or aluminium trihydrate) having a propellant (i.e. dimethyl ether or C3-C5 alkane or a mixture. The particles of alumina in the composition have size of 2-200 nm or between 5-50 nm. The claims are also drawn toward amounts of alumina particles in the composition (wt%) by weight; that the composition comprises of dimethyl ether as propellant (amounts present indicated), water and polyols: applicant claims that the composition comprises of water, ethanol or other C1-C4 alcohol as solvent.

Tanner et al (Patent '508) disclose composition alumia or boehmite (col 17, lin 20-24 and col 8, lin 20-26), propellant as carrier (col 8, lin 65; col 15, lin 1-5 and col 9, lin 10-25). Patent '508 discloses the use of solvents such as polyols (col 6, lin 55-60, col 14, lin 30-35) and other cosmetic ingredients (col 15, lin 1-30).

Patent '508 does not specifically mention that the alumina in the composition form the only source of particles

As discussed, Patent to Metzger et al (Patent '148) is relied upon as prior art invention disclosing the use of alumina particles and a propellant in a composition (abstract, col 1, lin 55 and col 2, lin 47-55) wherein the alumina particles have size of 0.005 – 0.1 microns.

One of ordinary skill in the art would have been motivated to make a composition useful for providing protection to the skin having a propellant as carrier for spraying to the composition onto the body. By adding a suitable carrier medium which is not disclosed in Patent '148, to the composition disclosed in Patent '148 (i.e. alumina particles of known particle size) one of

ordinary skill would have expect to obtain the beneficial effect of the composition disclosed in Patent '508 in a form that can be used for treating hair, e.g. in a shampoo formulation. Therefore the invention as a whole claimed by applicant would have been *prima facie* obvious at the time it was made.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: (a) Fowler et al (US 5, 534, 265) et al teach a personal cosmetic composition comprising polymer particles (polyethylene beads). The composition also comprises of alumina and aluminium oxide particles. The reference is not relied upon for the rejections because though the reference discloses the use of alumina particles, the examples fail to teach alumina particles as the sole particulate material in the composition.

### Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Retford Berko** whose telephone number is 571-272-0590. The examiner can normally be reached on M-F from 8.00 am to 5.30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Thurman K Page**, can be reached on 571-272-0602.

ReB

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ReB  
12/30/04

TKP